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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,350	03/12/2004	Edward J. Domanico	9417.6823	6355

44538 7590 04/04/2006

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EXAMINER

FRANCIS, FAYE

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,350

Applicant(s)

DOMANICO, EDWARD J.

Examiner

Faye Francis

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11, 12 and 14-20 is/are allowed.
- 6) ☒ Claim(s) 1-10, 13, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: proper antecedent basis should be provided in the specification for the teaching that the housing defining a bagless and sleeveless collection area, as recited in claim 24. No new matter should be entered into the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 24 is finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e., New Matter.

The specification as originally filed does not provide support for the teaching of "said housing defining a bagless and sleeveless collection area " as now recited in claim 24.

The following rejections have been made under the presumption that the new matter is not in the claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8, 10,13 and 23-24 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Deklerow [5,205,497] in view of Perry et al. [5,092,527], hereinafter Perry.

Deklerow discloses in Figs 1-2, a fluorescent lamp collection and disposal system comprising a hazardous material comprising: a housing/drum 11 having a side wall and bottom surface defining an interior area [Fig 1], a cover member 14 having a top surface, a tube member 22, means for breaking the fluorescent lamp [Fig 2], a pipe 23 which corresponds to the claimed hose member, connected at a first end to the cover member as recited in claims 1 and 21. Additionally, Deklerow discloses the tube member is positioned substantially perpendicular with the cover, means for breaking is connected to the drum cover and comprises: a spinner assembly having one or more blades [shaft S and flail 23], a motor assembly M in communication with the spinner assembly; and means for powering the motor assembly as recited in claim 3, the hazardous material is a mercury vapor [col 3 line 45] as recited in claim 7.

Deklerow does not disclose a multi stage filtering and vacuum assembly having a plurality of filter members and a vacuum motor creating a negative pressure vacuum within the interior of the housing; the multi stage filtering and vacuum assembly secured

to an exterior surface of the side wall of the housing, wherein a second end of the hose member is connected to the multi-stage filtering assembly such that the hose member is in communication with a first filter member of the multi stage filtering assembly; wherein the negative pressure vacuum causes at least a substantial portion of the hazardous material to be drawn through the hose member and into the multi stage filtering assembly as recited in claim 1. Also, Deklerow does not disclose wherein the plurality of filters include a HEPA filter and an activated carbon filter as recited in claim 4, the housing is a substantially 55 gallon drum as recited in claim 5, the plurality of filters further includes a collection bag, a substantially non-clinging Dacron filter bag; wherein a first stage of filtering is performed by the collection bag and a last stage of filtering is performed by the activated carbon filter as recited in claim 8 and a lamp receiving system in addition to the tube member as recited in claim 23.

Perry is cited to show desirability, in the relevant art, to provide a fluorescent lamp collection and disposal system with multi stage filtering and vacuum assembly having a plurality of filter members and a vacuum motor 61 creating a negative pressure vacuum within the interior of the housing [col 12 lines 3-64], wherein a second end of the hose member is connected to the multi-stage filtering assembly such that the hose member is in communication with a first filter member of the multi stage filtering assembly [Fig 1], wherein the negative pressure vacuum causes at least a substantial portion of the hazardous material to be drawn through the hose member and into the multi stage filtering assembly. Also, Perry shows a HEPA filter 55 and an activated carbon filter 29, the plurality of filters further includes a collection bag 53 and a

substantially non-clinging Dacron filter bag 57, wherein a first stage of filtering is performed by the collection bag and a last stage of filtering is performed by the activated carbon filter [Fig 1]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Deklerow with the multi stage filtering as taught by Perry in order to have a more efficient filtering system.

To the extent if Deklerow fails to disclose the substantially flexible hose, it would have been obvious to make the hose substantially flexible to save storage space. Additionally, at the time of invention it would have been obvious to use a substantially 55-gallon drum and a pressure gauge because they are very common.

With respect to the multi stage filtering and vacuum assembly secured to an exterior surface of the side wall of the housing: changing the location of the multi stage filtering and vacuum assembly from the location shown by Deklerow to a location exterior of the side wall of the housing, absent any criticality, is also considered an obvious modification of Deklerow's apparatus that a person having ordinary skill in the art at the time the invention was made would be able to provide using routine experimentation since the courts have held that there is no invention in shifting the position of a structure to a different position if the operation of the device would not be thereby modified. In re Japikse, 86 USPQ 70 (CCPA 1950).

With respect to the lamp receiving system in addition to the tube member. It is apparent that increasing the number of lamp receiving system would increase the productivity of the device. Additionally, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper

Co. v. Bemis Co., 193 USPQ 8. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the reasons stated above to further provide the modified device of Deklerow with additional lamp receiving system in order to increase productivity.

6. Claim 9 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Deklerow in view of Perry as applied to claims 1-8, 10,13 and 23-24 above and further in view of Deklerow [4,655,404], hereinafter Deklerow'404.

Modified device of Deklerow has most of the elements of this claim but for an extension member.

Deklerow'404 teaches that it is conventional to use an extension member 46 secured to a tube member in a fluorescent lamp collection and disposal system to guide the fluorescent lamp. It would have been obvious to one of ordinary skill in the art at the time the invention was made, in view of Deklerow'404 to further provide the tube in the modified device of Deklerow with an extension member in order to better guide the fluorescent lamp into the device.

Allowable Subject Matter

7. Claims 11-12 and 14-20 are allowed.

Response to Arguments

8. Applicant's arguments filed 3/27/06 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no teaching in the prior art to make the combination of the references.

The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re Simon, 174 USPQ 114 (CCPA 1972); In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969).

The question under 35 USC §103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989) and *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969).

As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. In re Beattie, 974 F.2d 1309,

24 USPQ2d 1040 (Fed. Cir. 1992); In re Dillon, 919 F.2d 688, 16 USPQ2d 1897, 1905 (Fed. Cir. 1990); In re Kronig, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976); In re Wilder, 429 F.2d 447, 166 USPQ 545 (CCPA 1970).

In this case, the artisan would have been motivated to provide the device of Deklerow with the multi stage filtering as taught by Perry in order to have a more efficient filtering system and to use a substantially 55-gallon drum and a pressure gauge because they are very common.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 571-272-4423. The examiner can normally be reached on M-F 6:30-3:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FF



Faye Francis
Primary Examiner
Art Unit 3725